

### **REMARKS**

Claims 2-5, 7-11, and 13-40 have been canceled without prejudice or disclaimer. Applicants reserve the right to file one or more continuation applications directed to the subject matter encompassed by all canceled claims. Upon entry of the present amendment, claims 1, 6, 12, and 41-64 will be pending. Claims 41-64 have been added to expand the embodiments of the elected subject matter. The new claims are supported by the specification as filed. No new matter has been added.

More particularly, support for new claims 41 and 53 can be found, for example, at page 11, paragraph [0055]; page 14, paragraph [0072] to page 15, paragraph [0080]; and at page 9, paragraph [0046] to page 10, paragraph [0048] (SEQ ID:2 polypeptide, the polypeptide encoded by the cDNA clone contained within ATCC Deposit No. 75913, and method of detecting a PSR protein in a biological sample). Support for new claims 47-52 and 59-64 can be found, for example, at page 9, paragraph [0046] and page 5, paragraph [0027] (tissue, cells, plasma, serum, saliva, and urine biological samples). Support for new claims 42-44 and 54-56 can be found, for example, at page 24, paragraph [0129] to page 25, paragraph [0132] (polyclonal, chimeric, humanized, single chain, Fab, human, and monoclonal antibodies). Support for new claims 45-46 and 57-58 can be found, for example, at page 9, paragraph [0046] and page 10, paragraphs [0049] to [0050] (antibody labels and radioisotopes). Thus, no new matter has been added by way of amendment.

### *Provisional Election*

On page 2 of the Office Action mailed August 25, 2004, the Examiner has separated the claims into three groups. The Examiner contends that the inventions are independent and/or distinct, each from the other, and thus, has required an election under 35 U.S.C. § 121. *See*, Paper No. 20040823, page 2. The Examiner has further required election of a single species. *See*, Paper No. 20040823, page 2, paragraph 5.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of new claims 41-64 drawn to methods of detecting PSR protein in a biological sample. Moreover, Applicants elect the sequence corresponding to SEQ ID NO:2 and that corresponding to the polypeptide encoded by the cDNA clone contained within ATCC Deposit No. 75913, for further prosecution.

Applicants submit that the subject matter of new claims 41-64 while fully supported by the specification as filed does not fall within the scope of the Groups I – III defined by the

Examiner in the Restriction Requirement, but nonetheless form a single group of claims (hereafter referred to as Group IV) organized according to the scheme set forth by the Examiner. Under M.P.E.P. § 818.02(a), an election may be made by the presentation of original claims. Applicants reserve the right to file one or more divisional applications directed to non-elected groups should the restriction requirement be made final.

Applicants respectfully traverse the restriction requirement as it applies to Groups I – III and newly presented group IV (see below). The Examiner asserts that the claimed methods are patentably distinct inventions. Even assuming, *arguendo*, the Examiner were correct, where two patentably distinct inventions appear in a single application, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden". See, M.P.E.P. § 803.

With respect to Groups I-III, the Examiner has not indicated that the different Groups have a different status in the art, or a different field of search, beyond the statement that the processes "are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success." See, Paper No. 20040823, page 2, penultimate paragraph. In fact, the Examiner has classified each of Groups I-III into the same class and subclass. M.P.E.P. § 808.02(C) states that:

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

Thus, the Examiner has not made a *prima facie* showing of serious burden with respect to Groups I-III. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn, at least as it applies to Groups I-III.

Furthermore, Applicants submit that it would not be a serious burden, to search the claimed processes for screening antagonists (Groups I - III) with the claimed methods of detecting PSR in a biological sample (Group IV). A search of the claims of elected Group IV could hardly be performed without searching the SEQ ID NO:2 polypeptide itself, a search that would clearly provide useful information for the remaining groups. For example, the search for publications which disclose methods of detecting a PSR protein in a biological sample by detecting the SEQ ID NO:2 polypeptide (Group IV), would lead the Examiner to references which disclose compounds which act as antagonists to the SEQ ID NO:2 polypeptide, which would be relevant to evaluation of the claims of Groups I – III.

Applicants submit that it would not be a serious burden to examine all the claims of Groups I-IV together.

Therefore, Applicants respectfully request that the present restriction requirement be withdrawn upon consideration of the above arguments and in view of M.P.E.P. § 803. Moreover, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

### **CONCLUSION**

Applicants respectfully request that the amendments and remarks above be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

No fee is believed to be due in connection with this filing, however if applicants are in error, please charge any fee deemed necessary to Deposit Account No. 08-3425.

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Respectfully submitted,

By 

Kenley K. Hoover

Registration No.: 40,302

HUMAN GENOME SCIENCES, INC.

Intellectual Property Dept.

14200 Shady Grove Road

Rockville, Maryland 20850

(301) 610-5771

KKH/PF/ba